UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
CHANKONG, DOHM

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 February 2010_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _14-56_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _14-56_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This final rejection is in response to Applicant's after-final arguments which was filed on 2/17/2010 and amendment which was filed on 6/9/2009. Claims 14, 18, 19, and 24 are amended. Claims 1-13 were previously cancelled. Accordingly, claims 14-56 are presented for further examination.

I.   RESPONSE TO ARGUMENTS

A.   The 35 U.S.C. § 101 rejection of claims 14 and 24 is withdrawn.

The inclusion of a storage unit as part of the claimed system overcomes the § 101 rejection because the claim now contains a hardware element. Therefore, the § 101 rejection of claims 14 and 24 is withdrawn.

B.   The 35 U.S.C. § 103(a) rejections are maintained because Applicant's arguments with respect to the claim limitations which were filed on 6/9/2009 are not persuasive.

Applicant's new limitation recite that the sender subsystem is permitted to add a new category to a listing of receiver categories. Applicant argues that *Gross* merely discloses a user or a human operator that performs the addition of the new category.

However, Applicant's claim language is broadly written and does not preclude interpreting user interaction as part of the process. For example, there is no language stating that the subsystem acts independently of a user, automatically, without user input, or any other phrase that would suggest that the subsystem is automated and can not rely on a user in order to add the new category.

Thus, if a reference teaches that human operator uses a subsystem to add a new category,

then that reference would meet the language of the claim because a subsystem is part of the

process. In order to prevent this interpretation, Applicant should amend the claim to more

precisely disclose that the subsystem acts independently of any user input. If so amended, the

new limitation would likely overcome *Gross*.

But as the claims are currently written, *Gross*' a user adds a category to a receiver's list of

categories by using his subsystem or agent. Therefore, *Gross* still reads on the new limitation.

Based on the foregoing, Applicant's arguments are not persuasive and the rejections set forth in

the previous action are maintained.

II.   CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

> A.   **Claims 14-17, 20-43, and 47-56 are rejected under 35 U.S.C. §103(a) as being
>   unpatentable over *Schiavone* et al, U.S Patent Publication No. 2002|0120600
>   ["*Schiavone*"], in view of *Gross* et al, U.S Patent Publication No.
>   20040111478 ["*Gross*"].**

Applicant should note that all citations are to *Schiavone* unless otherwise noted.

Claims 14, 37, and 52

As to claim 14, *Schiavone* as modified by *Gross* discloses an e-mail system for

exchanging messages among users of the system, the system comprising:

a sender subsystem for transmitting a message from a sender to a receiver, the sender

subsystem having access to a list of categories [0062 : *Schiavone*'s mailing software 170 reads

on Applicant's claimed sender subsystem | 0026 : senders "share knowledge of a common set of

message type specifiers" where *Schiavone*'s specifier reads on Applicant's claimed category];

and

a receiver subsystem for receiving the message, the receiver subsystem being in data

communication with the sender subsystem [0064 : the "recipient's communication device 150"

reads on Applicant's claimed receiver subsystem | 0026];

a storage unit [Fig. 5];

wherein the receiver subsystem is configured to permit the sender subsystem to add a

new category to a listing of receiver categories [*Gross,* Fig. 1: user using a personal computer

and system | 0263: sender making suggestions through his computer to the receiver], and

wherein the sender subsystem is configured to identify a category for the message based

on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software

and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to

initiate a categorization negotiation process with the receiver subsystem [0051: negotiating the

delivery of the email messages], that includes at least the steps of communicating the category to

the receiver subsystem [*Gross,* 0263], receiving an indication from the receiver subsystem

whether the category is available to the sender and adopting the category as a negotiated

category if the category is available or, if the category is not available, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is available to the sender [*Gross*, 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories], to associate the negotiated category with the message [*Gross*, 0046, 0263, 0268], and to transmit the categorized message to the receiver subsystem [0062-0064].

As indicated above, *Schiavone* does not expressly disclose that receiver subsystem is configured to permit the sender subsystem to propose new categories for adding to a listing of receiver categories or the feature of proposing an alternative category to the receiver subsystem if the category is not acceptable. However, these features were well known in the art at the time of Applicant's invention.

Gross is directed towards a system in which users identify how messages are to be processed using categorization techniques [0013]. *Gross* further discloses permitting the sender subsystem to propose new categories for adding to a listing of receiver categories [0263], proposing an alternative category if the category is not acceptable [0046, 0268], and a sender subsystem associating a category with a message upon receiving an indication that a receiver subsystem recognizes the category [0046: the receiver-approved tags are transmitted to the sender as the sender composes the message | 0263 | 0268].

It would have been obvious to one of ordinary skill in the art to have modified *Schiavone*'s system for negotiating email transactions to have included *Gross*' teachings.

Specifically, one would have been motivated to include the feature of enabling a receiver to either accept or reject sender-proposed categories into *Schiavone*'s negotiations functionality.

Such a feature improves *Schiavone*'s system because in allowing a receiver to restrict the distribution of the categories, messages may be appropriately categorized and processed according to the receiver's control [see *Gross*, 0044].

As to claims 37 and 52, as they do not teach or further define over the limitations of claim 14, claims 37 and 52 are rejected for at least the same reasons set forth for claim 14.

Claims 15 and 38

As to claim 15, *Schiavone* discloses the recognized category is identical to a receiver category [0062 : "list of shared specifiers"]. As to claim 38, as it does not teach or further define over the limitations of claim 15, claim 38 is rejected for at least the same reasons set forth for claim 15.

Claims 16, 17, 40, 41, and 53

As to claim 16, *Schiavone* discloses the recognized category is mapped from a receiver category [0062 : negotiated specifier is selected from the list].

As to claim 17, *Schiavone* discloses the recognized category is a new category added to a listing of receiver categories [0025 : *Schiavone* discloses scanning the text of the message and creating a new specifier based on the text of the message. Thus, the specifier is newly added. Also see *Gross*, 0261].

As to claim 40, as it does not teach or further define over the limitations of claim 16, claim 40 is rejected for at least the same reasons set forth for claim 16. As to claims 41 and 53,

as they do not teach or further define over the limitations of claims 16 and 17, claims 41 and 53

are rejected for at least the same reasons set forth for claims 16 and 17.

Claims 20, 21, and 42

As to claim 20, *Schiavone* discloses an intermediary subsystem, wherein the listing of

categories is provided to the sender subsystem through the intermediary subsystem [0026].

As to claim 21, *Schiavone* does not expressly disclose that the listing of categories is a

union of a first listing provided by the intermediary subsystem and a second listing provided by

the sender subsystem. However, *Schiavone* does disclose that the listing of categories is a result

of shared "knowledge of a common set of message type specifiers" [0026].

The term "common set" is well known to refer to a set of items in common between two

different sets. Thus, it would have been obvious for one of ordinary skill in the art to have

reasonably inferred from *Schiavone*'s use of the term "common set" that the listing of categories

was a result of a union of message type specifiers provided by the sender and the third party.

As to claim 42, as it does not teach or further define over the limitations of claims 20 and

21, claim 42 is rejected for at least the same reasons set forth for claims 20 and 21.

Claim 22

Schiavone does not expressly disclose a sender intermediary subsystem for

communicating with said intermediary subsystem to negotiate said category. However, the

concept of distributing different functionalities between different network elements, such as from

a sender to a sender's intermediary, is well known and obvious.

Schiavone does disclose that his system can be implemented by spreading out different

functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to

one of ordinary skill in the art to have implemented *Schiavone* with a sender intermediary subsystem to perform the sender's responsibilities.

Claims 23, 39, and 54

As to claim 23, *Schiavone* discloses a user interface for presenting the listing of categories to the sender subsystem to select the category therefrom [0025 : specify a mail type specifier by selection from a menu]. As to claims 39 and 54, as they do not teach or further define over the limitations of claim 23, claims 39 and 54 are rejected for at least the same reasons set forth for claim 23.

Claim 24

Schiavone discloses a system for classifying messages transmitted by a message exchange system, the message exchange system including a sending subsystem for transmitting a message from a sender to a receiver and a receiving subsystem for receiving the message, the system comprising:

a negotiation module, the negotiation module maintaining a listing of categories [0064 : *Schiavone*'s trust authority 200 reads on a negotiation module];

said negotiation module including a sender subsystem for initiating negotiation of a category and a receiver subsystem for providing the sender subsystem with an indication whether the category is acceptable to the receiver system [*Gross*, 0263, 0268],

a storage unit;

wherein the receiver subsystem is configured to permit the sender subsystem to add a new category to a listing of receiver categories [*Gross*, 0263: sender making suggestions to the receiver], and

wherein the sender subsystem is configured to identify a category for the message based on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to initiate a categorization negotiation process with the receiver subsystem [0051: negotiating the delivery of the email messages], that includes at least the steps of communicating the category to the receiver subsystem [*Gross*, 0263], receiving an indication from the receiver subsystem whether the category is available to the sender and adopting the category as a negotiated category if the category is available or, if the category is not available, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is available to the sender [*Gross*, 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories], to associate the negotiated category with the message [*Gross*, 0046, 0263, 0268], and to transmit the categorized message to the receiver subsystem [0062-0064].

See the rejection of claim 14 for reasons to modify *Schiavone* to include *Gross'* interactive negotiation process.

Schiavone also discloses a sender subsystem for initiating negotiation of a category and a receiver subsystem for providing the sender subsystem with the listing of categories [0026, 0064, 0066] however *Schiavone* does not expressly disclose that the sender and receiver subsystems are included in the negotiation module.

However, the concept of distributing different functionalities between different network elements, such as from a sender to a sender's intermediary, is well known and obvious.

Schiavone does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented *Schiavone* with a sender intermediary subsystem to perform the sender's responsibilities.

Claim 25

Schiavone discloses said sender subsystem having access to a listing of sender categories and is operative to deduce the category from the listing of categories maintained by the negotiation module and the listing of sender categories [0026, 0062 : "list of shared specifiers" : also see the rejection of claim 21].

Claim 26

Schiavone discloses the category is a common category belonging to the listing of sender categories and the listing of categories maintained by the negotiation module [0026 : also see the rejection of claim 21].

Claims 27 and 28

Schiavone does not discloses the category belonging to one of the two listings and is mapped or is a new category to a second category belonging to the other of the two listings. However, such as feature was well known in the art at the time of Applicant's invention. For example, *Gross* discloses the feature.

Specifically, *Gross* discloses selecting a category from a receiver listing and mapping it (of adding a new category) to a sender listing and allowing the sender to use the category specified by the receiver listing [0010, 0217]. It would have been obvious to one of ordinary skill in the art to have modified *Schiavone*'s email system to include *Gross*' teachings of mapping new

categories to a sender. Enabling the receiver to specify the categories used by the sender gives a

receiver more control over the categories that may be used by the sender.

Claim 29

Schiavone discloses the message exchange system further includes a plurality of

receiving subsystems for receiving the message for a plurality of receivers [0065], said

negotiation module further including a plurality of receiver subsystems, each of said plurality of

receiver subsystems being operative to provide said sender subsystems with an indication that

the category is recognized by each receiver subsystem [0026, 0066 : the recipient compliance

engine as part of the negotiation module | see rejection of claim 14].

Claim 30

Schiavone discloses establishing a common category for a subset of said plurality of

receivers and to associate said common category with the message for said subset of receivers

[0055].

Claim 31

Schiavone discloses the use of one or more intermediary subsystems, said one or more

intermediary subsystems having access to at least a separate listing of additional categories, and

wherein the category is identified from a union of said separate listing of additional categories

and the listing of categories [0026 : see rejection of claim 21 with respect to the concept of a

"common set." Adding "additional categories" would have been obvious to one of ordinary skill

in the art because a "common set" can refer to the union of multiple sets of items].

Claims 32 and 34

Schiavone discloses one of said one or more intermediary subsystems is selected by said

receiver subsystem or sender subsystem [0030 – selecting a trusted authority]. *Schiavone* does

not expressly disclose that the subsystems select the authority. However, such a feature is

implied by *Schiavone*'s teaching that the sender and receiver have a shared common set of

specifiers. This teaching implies that the sender and receiver have selected an intermediary to

which to send their set of specifiers.

Claim 33

Schiavone does not expressly disclose a search module for searching for an selecting said

one or more intermediary subsystems. However, such a feature is implied by *Schiavone*'s

teachings that there can be more than one intermediary subsystem [0066 : trusted authority

and/or another third party]. Since there are multiple intermediaries in *Schiavone*'s system, it

would have been obvious to one of ordinary skill in the art to have reasonably inferred the use of

a method to search and select from one of the multiple intermediaries.

Claim 35

Schiavone discloses presenting to a sender the listing of categories for the sender to select

the category therefrom [0025 – menu].

Claim 36

Schiavone discloses said negotiation module is configurable through the user interface to

either negotiate the category free of interactive input from the sender or to receive an indication

of the category from the sender through the user interface [0025 – sender selects a specifier].

Claim 43

Schiavone discloses obtaining the listing of categories includes:

obtaining a first listing of a first plurality of categories from a first intermediary,

retrieving a second list of a second plurality of categories from a storage location maintained by

said receiver subsystem, producing the listing of categories from a union of the first listing and

the second listing [0026, 0064]. *Schiavone* discloses that the listing of categories is a result of

shared "knowledge of a common set of message type specifiers". The term "common set" is well

known to refer to a set of items in common between two different sets. Thus, it would have been

obvious for one of ordinary skill in the art to have reasonably inferred from *Schiavone*'s use of

the term "common set" that the listing of categories was a result of a union of message type

specifiers provided by the sender and the third party. Additionally, *Schiavone* discloses the

receiver storing public preference data at the recipient's data store while the sender retrieves

categories from a trusted intermediary.

Claim 47

Schiavone discloses a method of transmitting a message to a receiver for a sender in a

message exchange system, the sender having a sender subsystem for sending the message and

the receiver having a receiver subsystem for receiving the message, the sender subsystem having

access to a listing of categories recognized by the receiver subsystem, the receiver subsystem

being configured to permit the sender subsystem to add a new category to a listing of receiver

categories [see rejection of claim 14], the method comprising:

obtaining a destination address from the sender for identifying the receiver [0023 – use of

an the receiver's email address];

receiving information from the sender to be included in the message [0025 – specifier based on content];

the sender subsystem initiating negotiation of category with the receiver subsystem to agree upon a negotiated category, the category being identified by the sender subsystem based on the information and the listing of categories [0026];

associating negotiated the category with the message [0025]; and

transmitting the categorized message to the receiver subsystem, the message being associated with the category [0024, 0025],

wherein the step of negotiating includes at least the substeps of communicating the category to the receiver subsystem [*Gross*, 0263], receiving an response from the receiver subsystem whether the category is available to the sender and either adopting the category as a negotiated category if the category is available or, if the category is not available, negotiating with the receiver subsystem by proposing an alternative category to the receiver subsystem and adopting the alternative category as the negotiated category if the alternative category is available to the sender [*Gross,* 0263: receiver may accept or reject the proposed category, 0268: sending an indication to the sender to recategorize a message according to newly accepted categories].

Schiavone does not expressly disclose the negotiating substeps. However, these substeps were well known in the art at the time of Applicant's invention. See the rejection of claim 14 for reasons to modify *Schiavone* to include *Gross*' interactive negotiation process.

Claims 48-51

As to claims 48-51, as they do not teach or further define over the limitations of claims 15-17 and 20, claims 48-51 are rejected for at least the same reasons set forth for claims 15-17 and 20.

Claims 55 and 56

Schiavone discloses inserting an indication of the category in a section or header of the message [0024].

B.   Claims 18, 19, and 44-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Schiavone* and *Gross*, in view of *Schiavone* et al, U.S Patent Publication No. 20020120748 ["*Koenig*"].

It should be noted that *Koenig* describes additional aspects of *Schiavone*'s invention. *Schiavone* makes explicit reference to the *Koenig* application [0068 : "Selective Delivery and Forwarding of Electronic Mail"]. Therefore, it would have been clear to one of ordinary skill in the art to have incorporated *Koenig* and *Schiavone* together to fully realize *Schiavone*'s invention.

Claims 18, 19, 45, and 46

As to claims 18 and 19, *Schiavone* does not expressly disclose storing or indexing the message according to the negotiated category. However, describing an additional aspect of *Schiavone*'s email system, *Koenig* discloses using the message specifiers (or identifiers) to store and index a copy of the categorized email messages in a categorized inbox [0039 : specifiers including "personal", "business"].

As to claims 45 and 46, as they do not teach or further define over the limitations of claims 18 and 19, claims 45 and 46 are rejected for at least the same reasons set forth for claims 18 and 19.

Claim 44

Schiavone does not expressly disclose storing the categorized message together with an indication of the category associated therewith. However, *Koenig* describes this aspect of *Schiavone*'s invention [0039].

III.   CONCLUSION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452